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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/905,261
Filing Date: July 13, 2001
Appellant(s): MACALISTER ET AL.

John MacAlister
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/12/2007 appealing from the Office action
mailed 4/18/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

Please note that page-6 of the Appeal Brief contains the list of claims presented in a table form which is summarized as follows:

Claims 1, 4-9, 14-18, 25-28 and 31-41 are pending.

Claims 2-3, 10-12, 19-24 and 29-30 are cancelled.

Claims 1, 4-9, 14-18, 25-28 and 31-41 are finally rejected and are on Appeal.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,038,803	WILKINS	3-2000
GB 2,333,050	TREGLOWN	7-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 24- 28, 33-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilkins (6038803).

Wilkins relates to a mount (D, E) consisting of a single layer of plastic such as PVC and having a first surface carrying an adhesive (col. 3, lines 50-60). The mount has first and second mutually opposite surfaces. The mount is shown to be flat and flexible (Figure 4). The first surface of the mount is releasably adhered to a backing material (F).

The intended use phrases such as "for mounting paper to glass", "which adheres the mount to only...mountable arrangement", etc. have not been given any patentable weight as said phrases are not found to be of positive limitation.

The phrase "capable of" or "not capable of" has also not been given patentable weight because said phrase only requires the ability to so perform and does not constitute a limitation in any patentable sense *In re Hutchinson*, 69 USPQ 138.

Wilkins also teaches a method for securing a first material to a second material comprising releasably adhering a first surface of a mount to the first material (F), which is well known to be paper in the adhesive art, with an adhesive carried by the first surface, and securing the second surface to a second material (1) without adhesive.

Claims 1,4-8, 10, 13, 16-19 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins.

Wilkins, as discussed above, fails to teach that the mount arrangement comprises a plurality of mounts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wilkins by providing the carrier to have thereon a plurality of mounts for facilitating handling and storage, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

The decorative display on the front of the mount would include a pigment material. The release paper liner layer in the adhesive art is conventionally known to have silicone coating thereon for releasability.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins in view of Walker (GB: 2272682) .

Wilkins, as discussed above, fails to teach that the sheet is in the form of a roll or a flat sheet. Walker discloses a polyvinyl chloride cling film in the form of a roll and from which pieces of the film can be removed. Therefore it would have been obvious to one having ordinary skill in the art to utilize Walker's teaching of using a roll for storing the cling film in the invention of Wilkins with the motivation for facilitating transportation and storability of the cling film product.

Further, with regard to the sheet being in a stack form, it would have been obvious to one having ordinary skill in the art to provide the sheet in a sheet or roll form because these two are art recognized equivalents for storing and transportation facilitation, and it would have been obvious to substitute stack for the roll.

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins in view of Mascarenhas (6171681).

Wilkins, as discussed above, fails to teach that the PVC mount comprises plasticizer. Mascarenhas discloses that most cling films are PVC film which are highly flexible, particularly when they contain additives such as plasticizers. The film generally comprise about 50-55% of plasticizer (col. 2, lines 7-15). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Mascarenhas' teaching of using plasticizer added to the PVC cling film in the invention of Wilkins with the motivation to render said PVC films flexible.

Claims 14-15 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins.

Wilkins, as discussed above, relates to a film having a certain thickness, but fails to teach that the thickness is up to 2 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wilkins by providing its PVC cling film to have thickness of less than 2mm for flexibility and conformability, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272,205 USPQ 215 (CCPA 1980).

Similarly, the film of Wilkins has a certain surface area and that the dimensions can be varied, but fails to teach that the area is 100 to 900 sqmm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wilkins by providing its PVC film to have a surface area of 100 to 900 sqmm for providing optimum coverage by the covering, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treglown (GB: 2333050) in view of Applicant's Admission.

Treglown relates to a tab or mount having adhesive on one surface and the tab is formed of PVC or polyethylene. However, Treglown fails to teach that the PVC has static cling property. Applicant admits, in the amendment filed on august 8, 2005, particularly in claim 1, that it is well known for PVC to have static cling property.

Therefore, it would have been obvious to one having ordinary skill in the art to utilize Applicant's admission by providing the PVC mount in the invention of Treglown to have static cling property.

With regards to the mount be transparent, the mount of Treglown can be polyethylene which is well known to be transparent.

(10) Response to Argument

At first, it is noted by the examiner that appellant has addressed the rejections by arguing the prior art references of Treglown and Wilkins, instead of arguing the rejections separately. See Appeal Brief, page-20, third paragraph, wherein appellant reasons as why the argument was changed from arguing the rejections to arguing the prior art references. This Appeal Brief is the result of two notices of non-compliance sent to the appellant on 1/10/2007 and 9/8/2006.

However, the **appellant is prosecuting the application himself** and that the Appeal Brief of 10/4/2006 did present the arguments pr 37 CFR 41.37(c)(1)(vii).

Turning to the substance of the arguments, the response is as follows:

Regarding appellant's arguments of Treglown reference (page-20, last paragraph of the Appeal Brief), appellant is informed that the phrase "mounting a poster to a glass" or the phrases in claim 1 such as "for mounting a sheet object to a glass", etc. are directed to intended use of the claimed product as explained in previous Office Actions (see Office Action of 5/25/2005, paragraph-8, which has been reproduced hereinabove in section (8), first rejection).

Further, the words "glass", "window", etc. cannot be argued separately and out-of-context by the appellant because "glass" is recited as part of the intended use phrases in claim 1 and "window" could not be located in the claim 1.

As for the word "cling", appellant has failed to show as to where in the instant claims 1 and 9 said word is recited. The rejection of claims 1 and 9 was made in the Office Action of 11/3/2005 because at that time the instant claim 1 contained the new matter phrase "it is well known for PVC to have static cling property" (which is taken as appellant's admission on the record because said phrase is part of the file history of the application as presented in the Amendment filed on 8/8/2005).

Appellant's argument that *the present application, which is invented as a new way to attach posters to, principally glass*, is not deemed to be convincing because said limitation could not be located in the instant claims 1 and 9.

With respect to Wilkins patent, appellant alleges that it does not teach a mount. This is not found to be persuasive because, in Wilkins, the covering is taken to be a mount as it mounted over a picture (see abstract, line 16).

As for appellant's argument that there is no reference in Wilkins to "having a first surface carrying an adhesive", presence of tacky adhesive with the covering mount is disclosed in col. 3, lines 56-60 and col. 4, lines 32-35.

Contrary to appellant's position that the adhesive is not part of the structure, it is noted that Wilkins does not teach that the adhesive is applied to the glass (see Appeal Brief, page-22, underlined phrases). Rather, Wilkins teach that the tacky may be (optionally) used to adhere the covering to the object, which is directed to a covering with an adhesive thereon when it is attached to the picture.

Appellant is directed to instant claim 1 which fails to teach "Nor is an adhesive specified to adhere the protective backing" (Appeal Brief, page-22, sixth paragraph) as alleged.

Regarding the argument presented in page-23, paragraph-1 in the Appeal Brief, appellant is directed to the Office Actions of 11/3/2005 (pages 2-3) and 4/18/2006 (pages 3-4), wherein said arguments were addressed, explaining that the structure of Wilkins teaches a PVC with adhesive on one surface thereof.

In response to argument for the method claims, appellant's attention is drawn to Wilkins, wherein the static cling covering sheet E is provided with a protective layer F on one side and the picture on the other side such that the layer F is secured to the picture. The presence of adhesive on one surface would provide for releasably adhering of the

sheet E to a first material and securing a second material to the sheet E without adhesive as recited in method claim 36.

As for claim 40, the Wilkins patent teaches that the static cling PVC (E) has adhesive on one surface and the other surface is without adhesive. This, given the broadest possible interpretation of the claim 40, shows that the adhesive surface of the static cling PVC is indirectly adhering to the paper (F) and the without-adhesive surface is indirectly securing the PVC (E) to the glass.

Additionally, in response to appellant's argument regarding the length of the examination and the use of prior art previously presented, appellant is informed that multiple Office Actions were the result of amendments made by the appellant during the course of the examination, and the use of previously presented prior art was also based on the amendments made by the appellant. For example, the prior art of Treglown was used in the Office Action of 11/3/2005 because of the addition of the new matter phrase in the instant claim 1.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Nasser Ahmad

Primary Examiner

Conferees:



Romulo Delmendo

Appeals specialist TC 1700



Rena Dye

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